

S/N 09/712,064

Response to Office Action Dated 04/01/2004

REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the 04/01/2004 Office Action.

Claims Amendments

Claims 1—15, 31—45 and 61—75 are original and 91—109 are previously presented.

The Kim Reference

The Kim Reference teaches a browser adapted to put advertisements onto the screen. In particular, Kim teaches an application which runs as part of, or in conjunction with, a browser program. The application periodically downloads advertisements (ads) when the browser is substantially idle and stores them locally (Abstract; lines 4—7). Kim detects transition from a first web page to a second web page, and takes advantage of the time during which it takes the second webpage to download (0045; lines 1—2) to display (0077; lines 5—10) the locally stored ads. Note that the ad may occupy the full window of the browser (0078; lines 2—5), a partial window, or may be positioned outside the window (0078; lines 10—13).

Therefore, Kim teaches browser technology configured *for the display of ads*, either in the full browser window, a part of the browser window or in a new window. The ads are displayed in response to a change from the first webpage to the second webpage. However—as the Office Action points out and the Applicant agrees—Kim does not disclose ignoring requests for a second window where the request was not initiated in response to user action.

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1 Kim mentions pop-up ads in four paragraphs. In 0009, Kim mentions that
2 pop-up ads may result in "consumers (becoming) upset and bothered." The
3 context for this statement is that pop-up ads are not a beneficial method for
4 advertising and that advertisers should advertise according to the methods of Kim.
5 The context of this statement is not that Kim is considering ways to fight pop-up
6 ads. Kim is only saying that Kim's way of advertising is a better way of
7 advertising. In 0038, Kim again indicates that pop-up ads are not an effective
8 advertising tool. In 0123 Kim mentions that pop-up ads can block the user's view,
9 and in 0145, Kim mentions the interference pop-up ads can cause. However,
10 nothing in Kim suggests that Kim is considering "fighting" pop-up ads; only that
11 Kim considers them to be an inferior method of advertising. Kim is in fact very
12 pro-advertising, having disclosed a system and method for advertising.
13 Accordingly, nothing in Kim suggests that Kim is considering the addition of an
14 apparatus or method of stopping pop-up ads.

15 The "How-To" Reference

16 In contrast to the browser software seen in Kim, the How-To reference
17 teaches *changing the code which comprises a website* to prevent the host from
18 inserting successful pop-up ads into responses sent by the website to hits made to
19 the website.

20 In particular, the How-To reference discloses a number of strategies by
21 which a website owner can change a website to prevent display of advertisements
22 which the host server of the website inserts. Accordingly, the How-To reference
23 does not disclose browser technology which ignores or follows instructions for
24 opening a second window. Instead, How-To discloses website modifications.
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1 In general, the background and teachings of How-To may be understood by
2 the following exemplary scenario:

- 3 1. A Website Admin writes code to configure a Website.
- 4 2. The Website Admin hires Host (an internet service provider (ISP))
5 to physically host the Website.
- 6 3. Website Admin notices that Host is injecting Host's pop-up ads into
7 the responses to "hits" on Admin's website. Website Admin is
8 upset, since Website viewers may avoid Website due to Host's
9 advertising.
- 10 4. Website Admin investigates and realizes that Host is employing any
11 of several methods to introduce the ads. Accordingly, Website
12 Admin must find out (1) what the Host is doing to introduce the pop-
13 up ads, and (2) consult How-To for indicated remedy. For example
14 to kill pop-up as they appear, Admin must check to see what Host
15 has named the window (How-To, middle of page 3 of 6).
- 16 5. Website Admin alters the code in Website (according to How-To's
17 instructions) to nullify Host's strategy of introducing pop-up ads into
18 Website Admin's Website.

19 Thus, we realize that How-To is adapted for use on a server or website host.
20 How-To instructs that the host may employ any of many strategies to insert pop-
21 up ads—accordingly, How-To provides six pages of possible solutions. None of
22 the solutions always works. Admin must find the solution that works in view of
23 what the host is doing. Admin must then change the code of the website. This is
24 not an option for a browser, who can't change the code of every website (or any
25 website, actually) that the browser visits.

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1 How-To's technology cannot be adapted for use on a browser, since only
2 the owner of a website—and not a browser visiting the website—can change the
3 code of the website. Therefore, How-To's technology cannot be combined with
4 Kim's browser to form the browser windows and browser modules recited by the
5 Applicant's claims.

6 **General Discussion of Kim and How-To**

7 Kim does not suggest pop-up ad blocking. The Applicant stresses that Kim
8 does nothing to suggest that pop-up ads can be blocked. Kim merely suggests that
9 they are annoying, and suggests that Kim's advertising technology is better.
10 Nothing in Kim's disclosure suggests blocking any type of ad.

11 There is no suggestion for combining Kim's browser technology with How-
12 To's server technology. Kim was cited by the Patent Office as an example of a
13 graphical user interface presenting a user with a browser window. How-To
14 teaches website-based technology with which a website can prevent the website's
15 host from adding pop-up ads to responses to "hits" on the website. There is no
16 suggestion in either reference for combining two such disparate technologies.

17 Kim assumes that the sever is cooperating; How-To assumes that the host is
18 inserting unwanted ads. Kim teaches that the server supplies the client with ads—
19 during lulls in transmission—which the client saves for display while the browser
20 waits for a page to load. In contrast, How-To teaches that changing the code
21 which comprises the website may reduce pop-up ads. Accordingly, these
22 technologies are based on substantially different foundations—and their
23 combination is unexpected.

24 How-To's technology cannot be adapted to use on a browser, and therefore
25 cannot be used to remedy the failure of the Kim browser in a rejection of the

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1 Applicant's recited browser windows and browser modules. How-To teaches—
2 *and this is an important point*—that each host computer may use a different
3 method by which the host's pop-up ads are inserted into the responses to hits on
4 How-To's website. For example, the host may name the pop-up ad window any
5 arbitrary name, and the website admin should find out that name as a part of the
6 fix (e.g. How-To middle of page 3, wherein the window is named "w"). Thus,
7 How-To teaches that examination of each host is necessary, for the website admin
8 to fix the pop-up problem. However, How-To is silent on the point of modifying a
9 browser to avoid pop-up ads. How-To only tells website owners how to change
10 their websites.

11 In contrast to How-To's technology which modifies the code of a website,
12 the Applicant's claims recite a browser. Claims 1, 31, 61 and 91 explicitly recite
13 "browser windows" and/or "browser modules." Therefore, Applicant's claims
14 recite systems and methods which operate on a client, which is configured to
15 receive requests, which may be sent by a website on a server. In contrast, How-To
16 teaches technology by which a website may be modified. How-To is not a
17 building block with which a browser could be built.

18 Rejection Under Section 103

19 Claims 1—15, 31—45 and 61—75 are 91—109 were rejected under 35
20 U.S.C. section 103(a) as being anticipated by U.S. application 2002/0052925
21 ("Kim") and the How-To document (How-To). The Applicant respectfully
22 traverses the rejection of claims 1—15, 31—45 and 61—75 are 91—109.

23 In particular, independent claims 1, 31, 61 and 91 define browser windows
24 and browser modules wherein a request to open a second browser window is
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1 received, and wherein the request is ignored if the request was not initiated by a
2 user action and granted if the request was initiated in response to a user action.

3 The Office notes, and the Applicant agrees, that *Kim fails to disclose*
4 *ignoring the requests if the request was not initiated in response to user action.*
5 However, the Office suggests that the How-To document discloses “ignoring the
6 request if the request was not initiated in response to a user action.” The
7 Applicant respectfully disagrees.

8 The Office was forced to attempt to find an example of “ignoring the
9 request if the request was not initiated in response to a user action” *since Kim does*
10 *the opposite*—i.e., Kim discloses and promotes the putting up of ads—either in
11 existing or new second windows—wherein the request generating the ad (and
12 second window) was “not initiated in response to a user action.” In other words,
13 Kim gives the web-surfer ads they didn’t ask for, *and this is the core of the Kim*
14 *reference.* For example, under the teachings of the Kim reference, if a user asks
15 for a second page (e.g. clicks a link) then before the user gets that second page, the
16 user gets an ad—either in the existing window or a new second window. (See
17 0078 and many other locations.) Thus, Kim teaches away from the idea of
18 ignoring second window requests not initiated in response to user action, and
19 instead teaches putting up second windows with ads not requested by user action.
20 This is not incidental to Kim’s teachings; generating and fulfilling second window
21 requests not in response to user action is the absolute core of the teachings of the
22 Kim reference. *Accordingly, since it is at the core of Kim's teachings to put up*
23 *second windows, and not to ignore requests for second windows not initiated in*
24 *response to user action, Kim teaches away from any reference (if one exists) which*
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1 ignores "the request (to open a second window) if the request was not initiated in
2 response to a user action".

3 The Kim and How-To references vigorously teach away from each other.
4 Kim is focused on providing advertisements to the web-surfer during the interval
5 between first and second web-pages the web-surfer intended to visit. How-To is
6 focused on preventing advertisements inserted by a website host. Thus, the two
7 references teach away from each other because they have different—almost
8 opposite—goals, i.e. preventing ads vs. providing ads. Moreover, the two
9 references teach away from each other due to their different approaches. That is,
10 Kim teaches a modification to a browser on a web-surfing client (which impacts
11 the experience of one web-surfer on many websites), and How-To teaches
12 modification of a website (which impacts the experience of many web-surfers on
13 one website). Such profound differences in approach and goals reinforce the view
14 that the references vigorously teach away each other.

15 The references additionally teach away from each other, in part, because
16 they cannot be combined into a workable system. As seen above, Kim loads an ad
17 into a (first or newly-opened second) window in response to a request not initiated
18 in response to user action. To disable this functionality from Kim, and to replace
19 it with the ad-stopping teachings of How-To (if this is possible), would completely
20 gut the functionality of the Kim reference. Kim would no longer deliver any ads,
21 which is Kim's only focus. Similarly, How-To would be unable to function within
22 a browser environment, since How-To teaches a plurality of ways to modify the
23 code of a website. That is, How-To teaches a variety of modifications which may
24 be made to a given website according to the particular operation of the website's
25 host. Thus, How-To teaches ways to modify the website so that the host's efforts

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1 to install pop-up ads fail. How-To is silent on how to modify a browser to stop
2 such ads.

3 Thus, Kim and How-To cannot be combined in a logical manner, and How-
4 To's technology cannot be used to remedy the failure of the Kim browser in a
5 rejection of the Applicant's recited browser windows and browser modules. The
6 core of Kim's teachings is to operate on a browser (an Internet client) to display
7 ads—not in response to user request—while the user is waiting for the web page
8 that they did request. The core of How-To's teaching is to re-write the code of a
9 website (using different strategies depending on the strategies of the host) to
10 prevent pop-up ads. If they were combined, it is unclear if they would operate on
11 server or client or if they would display or reject ads. *It is unclear how a browser*
12 *could ever be able to modify the code of any website, as How-To teaches website*
13 *owners.*

14 It is important to note that How-To's technology cannot operate on a
15 browser, since How-To must be configured to each website according to the ad-
16 injection strategy of the host. (See, for example, all of How-To's strategies, each
17 aimed to counter a different server ad-injection strategy.) Thus, How-To does not
18 teach technology that may be adapted for use with a browser (such as Kim's
19 browser) which surfs from host to host, each host might have different ad-injection
20 strategies. Thus, these two references—one intended to promote ads and one
21 intended to restrict ads—cannot be reasonably combined to form the browser
22 modules of the Applicant's claims.

23 Additionally, neither Kim nor How-To disclose evaluating "if the request"
24 was or was not initiated in response to a user action, as is expressly recited in the
25 claims. For example, paragraphs 2 and 3 in claim 1 reflect different evaluations of

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1 whether the request was or was not initiated in response to a user action. In
2 particular, Kim loads an ad into the first window, or opens a second window and
3 loads an ad into it, wherein the ad-loading is not in response to user action. How-
4 To attempts to modify website code to counteract any ads that the server/host may
5 have tried to slip in. Therefore, a combination of the two references would fail to
6 evaluate "if the request was" initiated "in response to a user action." Accordingly,
7 even when combined, the references of record do not teach this the elements
8 recited in the claims.

9 And still further, How-To does not actually ignore requests for second
10 windows, since How-To teaches modification of server or website software, which
11 does not actually receive any requests to open windows on the browser, and
12 therefore does not actually ignore the requests. Instead, How-To ways to re-write
13 websites to prevent or disable pop-up ads.

14 **Claims 2—15, 32—45, 62—75 and 92—105**

15 These claims are allowable due to their dependency on claims which are
16 allowable for the reasons seen above, as well as for reasons associated with the
17 elements recited in each claim.

18 **Claims 106—109**

19 Claims 106—109 are allowable as being dependent on claims allowable for
20 the reasons seen above, as well as for reasons associated with the elements recited
21 in each claim. In particular, claims 106—109 recite an example of how "in
22 response to user action" and "not in response to user action" can be determined.
23 Neither Kim nor How-To evaluate "if the request" was or was not initiated "in
24 response to a user action." Accordingly, neither Kim nor How-To disclose the
25 elements recited in claims 106—109, which are allowable for at least this reason.

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1 As seen above, How-To teaches a way by which the owner of a website can
2 modify the code of the website to prevent pop-up ads. The references of record do
3 not make clear how this technology could be utilized to result in the browser
4 windows and browser modules recited in the Applicant's claims.

5 Conclusion

6 As noted by the Office, the Kim reference does not disclose ignoring
7 requests for a second window if the request was not initiated in response to user
8 action. As noted by the Applicant, the *core* of Kim's teaching is actually to open
9 second windows not in response to a user action to display an ad. Moreover, the
10 How-To reference discloses strategies to prevent opening of a second window all
11 of the time, *as opposed to not in response to user action*. A combination of Kim
12 and How-To (if possible) would result in a clash between Kim's pro-advertising
13 strategies and How-To's anti-advertising strategies.

14 However, How-To's technology cannot be adapted for use on a browser,
15 since only the owner of a website—and not a browser visiting the website—can
16 change the code of the website (which is what How-To teaches). Therefore, How-
17 To's technology cannot be combined with Kim's browser to form the browser
18 windows and browser modules recited by the Applicant's claims.

19 Accordingly, claims 1—15, 31—45, 61—75 and 91—109 are believed to
20 be in condition for allowance. Applicant respectfully requests reconsideration and
21 prompt issuance of the present application. Should any issue remain that prevents
22 immediate issuance of the application, the Examiner is encouraged to contact the
23 undersigned attorney to discuss the unresolved issue.

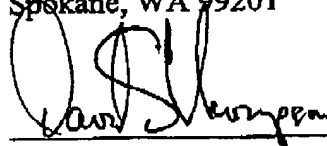
24 Respectfully Submitted,
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